

### REMARKS

Applicants' representative appreciates the courtesies extended during the telephonic interview of March 11, 2008. The amendments and remarks made herein are in accordance with those discussed during the telephonic interview.

The Final Office Action mailed February 6, 2008 considered claims 1-21. Claims 1-21 were rejected under 35 U.S.C. 102(b) as being taught by Ogilvie et al. (US 6,324,569) hereinafter *Ogilvie*.<sup>1</sup>

By this amendment, claims 1-3, 5, 7, 11-14, 18, 20 and 21 are amended and claim 22.<sup>2</sup> Claims 4, 6, 10, and 16-17 are deleted. Accordingly, claims 1-3, 5, 7-9, 11-15, and 18-22 are pending, of which claims 1, 14, 20, and 21 are the independent claims at issue.

The present invention is generally directed to decoupling attachments from electronic messages. For example, claim 1 recites a method for determining if an attachment is to be deleted in response to a deletion command requesting deletion of a corresponding electronic message. Claim 1 defines receiving an electronic message. The electronic message includes a message body, an attachment storing attachment data, and a coupling field. The coupling field indicates whether the attachment data is coupled to or decoupled from the message body. Coupling to the message body indicates that the attachment data is to be deleted along with the message body when the electronic message is deleted. On the other hand decoupling from the message body indicates that the attachment data is to be retained when the message is deleted.

Claim 1 also defines receiving a delete command requesting deletion of the electronic message. Next, claim 1 defines deleting the message body in response to and in accordance with the received delete command. Claim 1 then defines automatically referring to the coupling field included in the electronic message in response to the delete command to determine if the attachment data is to be deleted along with the message body or if the attachment data is to be retained based on whether the attachment data is coupled to or decoupled from the message body respectively. Lastly, claim 1 defines processing the attachment data in accordance with the indication in the coupling field based on the reference to the coupling field.

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<sup>1</sup> Although the prior art status of the cited art is not being challenged at this time, Applicant reserves the right to challenge the prior art status of the cited art at any appropriate time, should it arise. Accordingly, any arguments and amendments made herein should not be construed as acquiescing to any prior art status of the cited art.

<sup>2</sup> Support for the amendments to the claims are found throughout the specification and previously presented claims, including but not limited to paragraphs [0046], [0047] and Figures 1 and 3.

Claim 20 is a computer program product claim corresponding to the method of claim 1.

When attachment data is retained, the attachment data can be returned in response to queries for message related data. For example, claim 14 recites a method for identifying an attachment in response to a message related query. A query for message related data satisfying query criteria is received. The query is received subsequent to deletion of a message body and retention of a corresponding attachment. The retained attachment is identified as message related data that satisfies the query criteria notwithstanding that the message body was deleted prior to receiving the query. At least a link to the attachment is returned in response to the query.

Claim 21 is a computer program product corresponding to the method of claim 14.

Applicants respectfully submit that the cited art of record does not anticipate or otherwise render the amended claims unpatentable for at least the reason that the cited art does not disclose, suggest, or enable each and every element of these claims.

Claims 1-13 and 20 were rejected under 35 USC 102(b) as being anticipated by *Ogilvie*

*Ogilvie* describes mechanism related to self-removing e-mail messages. A message originator or intermediary associates removal indicators with removal code contained in an electronic message. (Col. 5, ll. 46-58). Removal indicators indicate to the removal code when to remove the message such that the receipt does not have to take manual action to delete the message. (Col. 5, l. 59 – Col. 7, l. 3).

Conventional options for handling attachments can be combined with removal indicators. (Col. 7, ll. 4-5). For example, electronic e-mail client programs can present an option to a user to retain or delete an attachment, in response to selecting the electronic mail message containing attachment for deletion. Thus, options similar to those used at e-mail client programs can be used to permit a user to specify whether or not to keep an attachment when a self-removing message containing the attachment is deleted. (Col. 7, ll. 5-11). For example, Eudora Pro permits one to specify whether an attachment is to be deleted when a message is manually deleted. Applicants submit that this requires, and is in fact solely based on, human interaction with and input to a messaging application the time the message is deleted. However, the decision to delete or retain an attachment in response to deletion of a corresponding electronic message is not automatic nor is it based on an indication included in the electronic message that is being deleted.

*Ogilvie* discloses that removal code for self-removal of a message can itself be included as an attachment to the message. (Col. 12, ll. 49- 50). However, the attached removal code does not make a decision related to how other attachments are to be retained or deleted in response to deletion of the message. That is, execution of the removal code does not change the manual process of determining whether to keep or delete other attachments to a message (if such a process is even included in a messaging application) when the corresponding electronic message is deleted (as described at (Col. 7, ll. 5-11)). Thus, any decision with respect to the deletion of other attachments is still based on and requires human interaction with and input to a messaging application. The decision is neither automated nor based on an indication included in the electronic message that is deleted.

Accordingly, the cited references fail to teach or suggest, either singly or in combination,

“an act of receiving an electronic message, the electronic message including:

a message body;

an attachment attached to the message body, the attachment storing attachment data associated with the electronic message; and

a coupling field indicating if the attachment data is coupled to or decoupled from the message body, coupling to the message body indicating that the attachment data is to be deleted along with the message body when the message body is deleted, decoupling from the message body indicating that the attachment data is to be retained when the electronic message is deleted;

...

an act of automatically referring to the coupling field included in the electronic message in response to the delete command to determine if the attachment data is to be deleted along with the message body or if the attachment data is to be retained based on whether the attachment data is coupled to or decoupled from the message body respectively; and

an act of processing the attachment data in accordance with the indication in the coupling field included in the electronic message based on the reference to the coupling field included in the electronic message.”

as recited in claim 1, wherein viewed in combination with the other limitations of claim 1. For at least this reason, claim 1 patentably defines over the art of record. At least for this same reason, claim 20 also patentably defines over the art of record. At least for this same claims 2-13 also patentable define over the art of record.

Further, a number of claims 2-13 also independently define over the art of record. For example, the cited art fails to teach or suggest, either singly or in combination the limitations of claims 13 and 22.

Claims 14-19 and 21 were also rejected under 35 USC 102(b) as being anticipated by *Ogilvie*. However, the office action provides neither citations nor reasoning identifying how *Ogilvie* anticipates each and every limitation of each of claims 14-19 and 21. Claims 14-19 and 21 contain limitations differing from claims 1 and 20. Accordingly, Applicants submit that the reasoning applied to claims 1-13 and 20 is not applicable to claims 14-19 and 21. Thus, Applicants respectfully request that support for the rejections to claims 14-19 and 21 be provided.

Claims 20 and 21 are rejected under 35 USC 101 because they are directed towards a data structure per se. Paragraph [0023] describes that physical storage media can carry or store computer-executable instructions ... or data structures. This states nothing more than how physical storage media is configured to operate. Even if not expressly stated, virtually any type of physical storage media can store instructions and data structures. However, paragraph [0023] does not imply that computer-executable instructions and data structures are one in the same, the two are separate and distinct forms of data that can be stored.

Claims 20 and 21 are rejected under 35 USC 101 because they are directed towards non-statutory subject matter because they are directed towards a connection. Applicants do not acquiesce to the validity of this rejection. Connections can include distinct and measurable physical characteristics. None the less, Applicants also submit that paragraphs [0023] and [0024] describe two distinct types of computer-readable media: physical storage media and connections respectively. Paragraph [0023] clearly describes types of physical storage media as distinct from connections as described in paragraph [0024].

Claims 20 and 21 expressly recite computer-executable instructions stored on physical storage media. Applicants submit that inferring that this claim language somehow incorporates

data structures and connections is incorrect. Applicants respectfully request that the 35 USC 101 rejections to claims 20 and 21 be withdrawn.

Claims 20 and 21 are rejected under 35 USC 112, second paragraph, as being indefinite because the purport to claim both a product and a claim. Claims 20 and 21 have been amended to remove recitations of "method". Applicants respectfully request that these 35 USC 112, second paragraph rejections, to claims 20 and 21 be withdrawn.

Claims 1-21 are rejected under 35 USC 112, second paragraph. Claims 1-21 recite "the message" which has insufficient antecedent basis and that the message is coupled and decoupled from itself. Claims 1, 14, 20, and 21 have been amended rendering these rejections moot. Applicants respectfully request that these 35 USC 112, second paragraph, rejections to claims 1-21 be withdrawn.

In view of the foregoing, Applicant respectfully submits that the other rejections to the claims are now moot and do not, therefore, need to be addressed individually at this time. It will be appreciated, however, that this should not be construed as Applicant acquiescing to any of the purported teachings or assertions made in the last action regarding the cited art or the pending application, including any official notice. Instead, Applicant reserves the right to challenge any of the purported teachings or assertions made in the last action at any appropriate time in the future, should the need arise. Furthermore, to the extent that the Examiner has relied on any Official Notice, explicitly or implicitly, Applicant specifically requests that the Examiner provide references supporting the teachings officially noticed, as well as the required motivation or suggestion to combine the relied upon notice with the other art of record.

In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney at 801-533-9800.

Dated this 2<sup>nd</sup> day of April, 2008.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Rick D. Nydegger", written in a cursive style.

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